

### **REMARKS**

Claims 1-11, 13, 15, and 18-21 are currently pending. Claims 18 and 21 have been amended.

#### **Rejections in Light of Bryan et al. U.S. Patent 5,674,296**

Regarding the rejection in light of Bryan et al. U.S. Patent 5,674,296, this patent is not available as prior art because it is not "by another." Specifically, the **exact same inventive entity** exists both in the present application and Bryan et al. U.S. Patent 5,674,296.

The Examiner has suggested that Applicants submit an affidavit or declaration under 37 CFR 1.132 stating "that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention 'by another'[" pg. 2 of the Office Action relying on MPEP 2136.05. However, MPEP 2136.05 is premised that the rejection under 35 USC § 102(e) was proper in the first place, which is not the case.

Specifically, the discussion of "Overcoming a Rejection Under 35 USC 102(e)" in MPEP 2136.05 is premised on there being a "Different Inventive Entity; Meaning of 'By Another'" as discussed in MPEP 2136.04. However, when the inventive entities are **identical**, 102(e) does not apply as a matter of law, and there is no reason to analyze derivation from a first inventive entity to a second, different inventive entity.

Furthermore, there would be nothing for an affidavit or declaration to state that has not already been stated with the inventor's declaration filed in the present application.

#### **Rejections in Light of Mehdizadeh US Patent 5,928,284**

Claims 18-20 stand rejected under 35 USC 102(e) over Mehdizadeh US Patent 5,928,284 moot. Claim 18 requires that the " resilient, viscoelastic disc [be] interposed between and contained within the interior surfaces of the housing parts." The structure of Mehdizadeh that the Examiner compares to this is the resilient portion 13 and in col. 2, lines 51-57, "filling the channel 17 with additional body compatible elastomeric substance and retaining it within the channel by use of the cap 18". As can be seen from the Mehdizadeh drawings, neither the

resilient portion 13 nor the cap 18 is "interposed between and contained within the interior surfaces of the housing parts" as is required in claim 18 of the present application. Therefore, claim 18, and the claims depending thereon, are deemed to be novel over Mehdizadeh and the cited art.

Rejections in Light of Rogozinski US Patent 5,888,226

Claim 11 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Rogozinski US Patent 5,888,226. This rejection is respectfully traversed. Claim 11 requires "a hollow cylindrical housing". The shapes of the housing 20 identified by the examiner are not cylindrical. For one, they both include a base plate member 23. Also, there is no longitudinal axis of the Rogozinski housing, which would be required for something to be "cylindrical". Therefore, claim 11 is deemed to be novel over Rogozinski and the cited art.

Conclusion

The Examiner is invited to contact the undersigned at the numbers provided below if further consideration is required. Also, Deposit Account No. 08-1394 may be used for any over or under payments.

Respectfully submitted,



David M. O'Dell  
Registration No. 42,044

Date: 7-12-05  
HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 972/739-8635  
Facsimile: 214/200-0853  
Attorney Docket No.: 31132.67  
R-110462\_1.DOC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Non Fee Amendment Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
Date: <u>7-12-05</u>
<u>Gayle Conner</u>
Gayle Conner